

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	) Confirmation No.: 2445
Yasuyuki ARAI et al.	) Examiner: Daryl C. Pope
Serial No.: 10/586,049	) Group Art Unit: 2612
Filed: July 14, 2006	)
For: FILM-LIKE ARTICLE AND METHOD	)
FOR MANUFACTURING THE SAME	)

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The present *Request* is filed pursuant to the provisions of the Pre-Appeal Brief Conference Pilot Program (1296 Off. Gaz. Pat. Office 67 (July 12, 2005); extended January 10, 2006).

The Official Action mailed March 31, 2010, and the *Advisory Action* mailed August 19, 2010, have been received and their contents carefully noted. Filed concurrently herewith is a *Request for Three Month Extension of Time*, which extends the shortened statutory period for response to September 30, 2010. Also, filed concurrently herewith is a *Notice of Appeal*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The Official Action includes improper rejections, errors in fact and omissions of essential elements required to establish a *prima facie* rejection.

Claims 2, 4-6, 9-11, 14-16, 19-21, 24-26, 29-31, 33, 35-37, 40-42, 45 and 47 are pending in the present application, of which claims 2, 5, 6, 45 and 47 are independent.

For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action continues to reject claims 1-48 as obvious based on U.S. Patent No. 6,497,371 to Kayanakis. Claims 1, 3, 7, 8, 12, 13, 17, 18, 22, 23, 27, 28, 32, 33 (as it depends from claims 28 and 32), 34, 38, 39, 43, 44, 46 and 48 have been canceled without prejudice or disclaimer in the *Supplemental Amendment* filed herewith; therefore, the above-referenced rejections are moot with respect to these claims. With respect to claims 2, 4-6, 9-11, 14-16, 19-21, 24-26, 29-31, 33, 35-37, 40-42, 45 and 47, the Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

Please incorporate by reference the citation of case law at page 2 of the *After Final Response* filed June 30, 2010.

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Independent claims 2 and 47 are directed to an integrated circuit inside (or enfolded in) a film-like article and an antenna outside (or on a surface of) the film-like article; independent claims 5 and 45 are directed to an integrated circuit and an antenna outside (or on a surface of) the film-like article; and independent claim 6 is directed to an antenna inside a film-like article and an integrated circuit outside (or on a surface of) the film-like article. These features are summarized in the following chart:

claim	inside the film-like article	outside the film-like article
2, 47	integrated circuit	antenna
5, 45		integrated circuit + antenna
6	antenna	integrated circuit

For the reasons provided below, Kayanakis does not teach or suggest the above-referenced features of the present invention.

Please incorporate by reference the detailed arguments set forth at pages 4-5 of the *After Final Response* filed June 30, 2010.

The *Advisory Action* confirms that Official Notice is not being relied upon as the basis for the present rejections of independent claims 2, 5, 6, 45 and 47 (page 4, lines 12-15; Paper No. 20100815).

The *Advisory Action* concedes that “Kayanakis does not specifically teach an embodiment in which the antenna is placed outside of the article” (page 4, lines 17-18, *Id.*). The *Advisory Action* asserts that “this does not preclude one of ordinary skill in the art modifying the device of Kayanakis such that this would have occurred” (page 4, lines 18-20; *Id.*). However, the legal standard in a *prima facie* case of obviousness is not whether the prior art does not preclude a hypothetical modification, but rather why one of ordinary skill in the art the time of the present invention would have had sufficient reasons to necessarily make the proposed modification.

Indeed, it is noted that the *Advisory Action* and the previous Official Actions do not provide any clear rationale supporting the alleged *prima facie* case of obviousness. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit (KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, 82 USPQ2d 1385). The Court quoting In re Kahn (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396. In the present application, the Official Action appears to contain mere conclusory statements, for example, at page 3, lines 14-18, and page 5, lines 13-16 of Paper No. 20091025, and the Official Action has not articulated reasoning with some rational underpinning to support the assertion of *prima facie* obviousness. Despite a previous request that the Examiner provide a clear rationale to support the alleged *prima facie* case of obviousness (see page 15 of the *Amendment* filed February 1, 2010), the *Advisory Action* continues to fail to provide any clear rationale beyond mere unsubstantiated, conclusory statements.


The *Advisory Action* asserts that “[t]o state that it would not have been possible is purely speculative on the applicant’s part, since the prior art of record does not specifically teach against this possibility” (page 4, lines 21-23, *Id.*). The Applicant did not argue that “it would not have been possible” to modify Kayanakis such that the antenna is placed outside of the article. While the Applicant does not concede this point, the Applicant notes that the previous argument was that the Official Action has not set forth sufficient reasons why one of ordinary skill in the art the time of the present invention would have modified Kayanakis in this manner, because such modification would frustrate the intended purpose of Kayanakis, which is indicia of non-obviousness. See page 5, line 3+, of the *Amendment* filed June 30, 2010, and MPEP § 2143.01, Part V. Also, as noted in MPEP § 2143.01, Part VI, if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The Examiner’s proposed modification appears to frustrate the intended purpose of Kayanakis and changes the principle of operation of Kayanakis (see column 3, lines 40-51 of Kayanakis). Therefore, there is no suggestion or motivation to make the proposed modification and the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Therefore, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are in order and respectfully requested. Since the Official Action has not presented a *prima facie* rejection, at the very least, the Examiner’s arguments are not suitable for appellate review. The Applicant respectfully requests that the present application be allowed on the existing claims pursuant to the provisions of the Pre-Appeal Brief Conference Pilot Program (1296 Off. Gaz. Pat. Office 67 (July 12, 2005); extended January 10, 2006).

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,



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